REMARKS

In response to the final Office Action dated June 21, 2005, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

Claims 1-2, 4-6, 12-14, 16-17, 19, 21-22, and 24 are pending in this application. The United States Patent and Trademark Office (the "Office") finally rejected claims 12-13 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. Claims 1-2, 4-6, 14, 16-17, 19, 21-22, and 24 were finally rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Duphorne* in view of U.S. Patent 6,374,102 to Brachman *et al.* The Assignee shows, however, that the pending claims already distinguish over the cited documents.

Rejection of Claims 12 & 13 under § 102

Claims 12 and 13 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended claim 12 distinguishes over *Duphorne*, so the Assignee respectfully requests that Examiner Won remove the 35 U.S.C. § 102 (e) rejection.

Duphorne does not anticipate claims 12 and 13. Independent claim 12 recites features not taught or suggested by *Duphrone*. Independent claim 12, for example, recites "*looking up the email addressee in a database to identify an internet protocol address and a user name associated with the email addressee, the internet protocol address associated with the shared broadband appliance.*" Moreover, claim 12 further recites "*sending an instruction from the*

page 7

application server to the shared broadband appliance based on the internet protocol address, said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name." Support for such amended features may be found at least at paragraph [0033] of this application. Amended claim 12 is reproduced below.

12.   (Currently Amended) A method for delivering a notification of an email arrival to a shared broadband appliance, said method comprising:

receiving a message on an application server, said message including at least an email addressee;

looking up the email addressee in a database to identify ~~at least~~ an internet protocol address and a user name associated with the email addressee, *the internet protocol address associated with the shared broadband appliance*; and

sending an instruction from the application server to the shared broadband appliance based on the internet protocol address, said instruction including at least the user name and directing the broadband appliance to display a notice directed to the user name.

Duphorne does not anticipate independent claim 12. Examiner Won is correct — *Duphrone* describes a "user notification parameter database" containing a user's email server Internet address. U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 4, lines 38-39. *See also id.* at column 4, lines 54-56. Yet *Duphrone* fails to describe "*looking up the email addressee ... to identify an internet protocol address .... the internet protocol address associated with the shared broadband appliance*," as claim 12 recites. No where does *Duphrone* disclose looking up an internet protocol address associated with the shared broadband appliance. *Duphrone* only retrieves an IP address of the mail server, not the IP address of the shared broadband appliance. *Duphrone*, then, cannot anticipate independent claim 12 and dependent claim 13.

Duphorne also fails to disclose other features. Independent claim 12, for example, recites "*sending an instruction from the application server to the shared broadband appliance based on the internet protocol address*." Examiner Won points to column 4, lines 8-13 of *Duphrone*, but the Examiner is, respectfully, mistaken. As this response above explains, while *Duphrone* may

retrieve an IP address, that retrieved IP address is associated with the mail server. No where does *Duphrone* disclose obtaining or using an IP address of the user's shared broadband appliance. Moreover, *Duphrone* explains a "preliminary" email notification signal that is sent from the email server to a callerID server in a central office. *Duphrone* at column 4, lines 8-10 and lines 18-20. The callerID server then formats that preliminary email notification signal into a Caller ID-compatible email notification signal. *See id.* at column 4, lines 21-23. The formatted Caller ID-compatible email notification signal is then transmitted to the user's callerID box. *See id.* at column 4, lines 23-24. *Duphrone*, then, sends two separate messages — a first message from the email server to the callerID server, and a second, formatted message from the callerID server to the user's callerID box. No where, then does *Duphrone* disclose "*sending an instruction from the application server to the shared broadband appliance based on the internet protocol address.*"

Duphorne, then, does not anticipate independent claim 12. Because *Duphrone* fails to disclose all the claimed features of independent claim 12, *Duphrone* cannot anticipate claims 12 and 13. The Assignee, then, respectfully requests that Examiner Won remove the 35 U.S.C. § 102 (e) rejection.

Rejection of Claims under 35 U.S.C. § 103 (a)

Claims 1-2, 4-6, 14, 16-17, 19, 21-22, and 24 were finally rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Duphorne* in view of U.S. Patent 6,374,102 to Brachman *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the proposed combination of *Duphorne* and *Brachman* fails to teach or suggest all the features of independent claims 1, 14, and 19. There is no suggestion in *Duphrone* of

multiple, distinctive ring tones, nor any database parameter for specifying a ring tone, so there is no basis for combining *Duphrone* and *Brachman* to obviate the pending claims.

As this response will explain, *Duphrone* makes no suggestion of multiple ring tones. All that can be logically stated is that *Duphrone* provides the same "special ringing signal" to all users. When *Duphrone* mentions "preferred email notification signal format," this term determines the format of CallerID-compatible signals transmitted to the user. No where does *Duphrone* teach or suggest anything related to multiple ring tones. When *Duphrone* is properly read and interpreted, *Duphrone* makes no teaching, suggestion, or motivation to combine aspects of *Brachman* to obviate independent claims 1, 14, and 19. One of ordinary skill in the art, then, would not think independent claims 1, 14, and 19 obvious in view of *Duphorne* and *Brachman*. Examiner Won, then, is respectfully requested to remove the § 103 (a) rejection.

No where does *Duphorne* suggest the features of independent claims 1, 14, and 19. These independent claims all recite "*retrieving a distinctive ring tone from multiple ring tones associated with the directory number.*" *Duphorne* makes no provision for storing, nor retrieving, a distinctive ring tone associated with a directory number. It is true that *Duphrone* describes a "special ringing signal" to alert of unread email messages. U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 10, lines 15-19. This special ringing signal is "periodically" provided by the central office to alert the user's telephone of unread email messages. *Id.* at column 10, lines 16-17. Because *Duphorne* makes no mention of, nor provisions for, storing and retrieving a distinctive ring tone from multiple ring tones, the only logical conclusion is that *Duphrone* provides the same "special ringing signal" to all users. That is, *Duphrone* teaches that all users receive the same "special ringing signal" when unread email messages are present.

Examiner Won points to *Duphrone's* "user notification parameter database." *Duphrone* at column 3, lines 26 and 31-32. This database includes information describing a "preferred email notification signal format." *See id.* at column 4, lines 44-45. Examiner Won states that this "preferred email notification signal format" "suggest[s] or invite[s] alternate embodiments," supposedly describing the distinctive ring tones of independent claims 1, 14, and 19. Yet

page 10

Examiner Won is, respectfully, mistaken. As the Assignee shows, when *Duphrone* is carefully read, this "preferred email notification signal format" has nothing to do with ring tones. This "preferred email notification signal format," on the contrary, describes the header and content of email notification messages. When this "preferred email notification signal format" is properly interpreted, it fails to suggest combining *Duphorne* and *Brachman* to obviate independent claims 1, 14, and 19.

Duphrone provides an explanation. The "preferred email notification signal format" "indicates the number of text lines of each email message to be included in the email notification signal." U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 4, lines 63-65. "The query software access the user notification parameter database and to retrieve the line entry which corresponds with the user." *Id.* at column 5, lines 14-16. Once the email server and the query software exchange username and password, the email query software issues a command to deliver "the number of text lines" of an email. *Id.* at column 5, lines 46-52 and lines 60-64. The email server forwards a "preliminary email notification signal" to the central office, and this signal includes header information and the predetermined number of text lines. *Id.* at column 5, line 65 through column 6, line 3. The email query software filters the preliminary email notification signal according to the user's line entry in the user notification parameter database. *See id.* at column 6, lines 10-13. The query software then formats the resulting information into a CallerID-compatible email notification signal. *See id.* at column 6, lines 14-15. A CallerID server then forwards the formatted CallerID-compatible email notification signal to the user. *See id.* at column 6, lines 15-18.

Duphrone describes another embodiment using 8-bit words. When the "email notification information is extracted from the ISP email server," it is "formatted into a CallerID-compatible signal having a plurality of 8-bit words." U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 8, lines 42-45. Some of the 8-bit words are "data words" that contain email notification information "according to parameter field values stored in a corresponding line entry of the user notification parameter database." *Id.* at column 8, lines 50-57.

As Examiner Won may now realize, *Duphrone* fails to teach, suggest, or even motivate one to combine aspects of *Brachman*. *Duphrone* fails to make any suggestion of a distinctive ring tone chosen from multiple ring tones associated with the directory number. All that can be logically stated is that *Duphrone* provides the same "special ringing signal" to all users. When *Duphrone* mentions "preferred email notification signal format," this term determines the format of CallerID-compatible signals that are transmitted to the user. No where does *Duphrone* teach or suggest anything related to multiple ring tones. When *Duphrone* is properly read and interpreted, *Duphrone* makes no teaching, suggestion, or motivation to combine aspects of *Brachman* to obviate independent claims 1, 14, and 19. One of ordinary skill in the art, then, would not think independent claims 1, 14, and 19 obvious in view of *Duphorne* and *Brachman*. Examiner Won, then, is respectfully requested to remove the § 103 (a) rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or *scott@scottzimmerman.com*.

Respectfully submitted,

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390

page 12